

REMARKS:

• **Status of the Claims**

Claims 34-36, 38-40, and 42-54 are pending in the present application.

• **Issues under 35 U.S.C. §112, Second Paragraph**

In the Office Action dated January 19, 2006, the Examiner rejected the claims pursuant to 35 U.S.C. §112, ¶2 as being indefinite for lacking a nexus between the preamble and the claim steps. Claim 35 has been rejected pursuant to 35 U.S.C. §112, ¶2 because clarification is sought regarding whether the “control genes” on line 6 are the same as the “control genes” on line 8. Applicant has addressed these concerns by amending the pending claims to include the step of “identifying genes whose expression is altered by the disease, age or exogenous agent,” as suggested by the Examiner. Additionally, claim 35 has been amended to modify the “control genes” on line 8 with the term “other” in order to distinguish the “control genes” on line 8 from the “control genes” on line 6. Accordingly, Applicant requests that the rejections pursuant to 35 U.S.C. §112, ¶2 be withdrawn.

• **Issues under 35 U.S.C. §§102 and 103**

In the Office Action dated January 19, 2006, the Examiner rejected claims 34, 38-40 and 42-46 pursuant to 35 U.S.C. §102 (b) or §103 (a) as being anticipated or obvious in light of Heller, et al. (1997). The Examiner has additionally rejected claims 34, 38-40 and 42-46 pursuant to 35 U.S.C. §102 (b) or §103 (a) as being anticipated or obvious in light of DeRisi, et al. (1996).

The invention of pending claims 34, 38-50 and 42-46 is a method for screening for genes

whose expression is altered by disease, age or exogenous agent. The genes being screened are all under the control of the same regulatory element. In this regard, not only must the genes being screened each have regulatory elements, but they must include the same regulatory element.

Although all genes are understood to be under the control of a promoter, not every promoter in every gene includes the same nucleotide bases, i.e., there are different promoters. As such, even if every gene includes a promoter, it cannot be said that every gene includes the same promoter. Similarly, it cannot be said that every gene includes the same regulatory element.

In order to clarify the claimed requirement that “expression of all of the genes is under the control of the same regulatory element,” an amendment has been made. Pursuant to this amendment, Claim 34 and the claims depending therefrom include the following requirement: “wherein expression of all of the genes is under control of the same regulatory element, which regulatory element contains defined nucleotide bases to which an enhancer or a repressor may bind.” This amendment does not contain new matter. (See e.g., Paragraph [0013] of U.S. Publication No. 2002/0009736, the publication of the original application).

Neither Heller, et al. nor DeRisi, et al. teaches or suggests providing a microarray including genes that are each under the control of the same regulatory element, which regulatory element contains defined nucleotide bases to which an enhancer or a repressor may bind. As such, the references neither directly nor inherently anticipate or make obvious the claimed method. Accordingly, Applicant requests that the rejections pursuant to 35 U.S.C. §§102 and 103 be withdrawn.

To the extent that a position was taken in the Office Action mailed January 19, 2006 that

original Claim 32 of the application contained a definition or the only definition of "regulatory element," the Applicant wishes to provide clarification for the record. Original Claim 32 included the following language: "The microarray of claim 30, wherein the regulatory element is an enhancer or a promoter." The couplet, "enhancer or promoter," was provided in original dependent claim 32 to assist in describing one species of a microarray, not to define "regulatory element." A description in the original application related to regulatory elements may be found, for one example, in paragraph [0045] of the publication of the original application.

In light of the foregoing remarks, Applicant respectfully requests allowance of all claims now pending in this Application. If, after reviewing this response, there are continuing concerns, the undersigned counsel would welcome the opportunity to speak with the Examiner to discuss possible resolutions.

Respectfully submitted,

A handwritten signature in cursive script that reads "Mandy Wilson Decker".

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